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V.O

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/021,956	02/11/98	KATZ R	232/117

LM01/0904

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EXAMINER	
WOO, S	
ART UNIT	**PAPER NUMBER**
2743	6

DATE MAILED: 09/04/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
09/021,956	Katz
Examiner	**Group Art Unit**
Stella Woo	2743

☐ Responsive to communication(s) filed on _____ .

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 24-126 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 24-126 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____ .

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____ .

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 5

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 24-126 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-54 of U.S. Patent No. 5,787,156. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in the present application are broader than the previously patented claims (In re Van Ornum and Stang, 214 USPQ 761).

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 77-78, 81-82 are rejected under 35 U.S.C. 103(a) as being unpatentable over Entenmann et al. (Entenmann) in view of the reference entitled "The AT&T Multi-Mode Voice Systems - Full Spectrum Solutions for Speech Processing Applications" by Hester et al. (Hester).

Entenmann discloses a telephonic-interface control system for a game of chance comprising:

interface means (col. 2, lines 54-56);

voice generator means (announcement system 17);

processing means (control processor 8);

qualification means (col. 2, line 65 - col. 3, line 4);

means for storing (database 19).

Although Entenmann provides for a plurality of lotteries (plurality of formats) being controlled by the same system (col. 2, lines 47-48), it differs from claims 77-78, 81-82 in that it does not specify the use of DNIS for selecting from the plurality of formats. However, Hester teaches the well known use of DNIS for access to a plurality of formats (page 3, second paragraph) such that it would have been obvious to an artisan of ordinary skill to incorporate the use of DNIS, as taught by Hester, within the lottery system of Entenmann in order to automatically identify the selected lottery format from a plurality of lottery formats using DNIS.

5. Claims 24-76, 79-80, 83-88 are rejected under 35 U.S.C. 103(a) as being unpatentable over Entenmann in view of Hester, as applied to claims 77-78, 81-82 above, and further in view of Barr and Muller et al. (Muller).

The combination of Entenmann and Hester differs from claims 24-76, 79-80, 83-88 in that it does not specify a distinct indicia, or bar code number, co-related to at least a portion of the identification number provided on the ticket. However, Barr teaches the well known use of

lottery ticket provided with a lottery number to be entered by dialing in to a provided telephone number and Muller teaches the conventional use of a bar code number co-related to the lottery identification number for the purpose of providing a high level of security when verifying winning tickets (Abstract) such that it would have been obvious to an artisan of ordinary skill to incorporate the use of a lottery ticket, as taught by Barr, and the use of a bar code, as taught by Muller, within the combination of Entenmann and Hester.

6. Claims 89-126 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Entenmann, Hester, Barr and Muller, as applied to claims 24-76, 79-80, 83-88 above, and further in view of Run, Jr. et al. (Run).

The combination differs from claims 89-126 in that it does not specify the use of visual indicia illustrative of a specific theme along with a name or numerical value associated with said specific theme. However, as shown by Run (Figs. 1, 2), it is well known in the lottery art to provide for visual indicia illustrating a specific theme along with identification of the particular lottery (which can be either name or numerical value). Since the combination clearly provides for a plurality of different lottery formats (Entenmann provides for a plurality of lotteries which can have different payoff amounts; col. 2, lines 42-48), it would have been obvious to an artisan of ordinary skill to identify the different lottery formats via different visual indicia shown on the lottery card along with either the particular lottery name and/or payoff amount.

7. Applicant's arguments with respect to claims 24-126 have been considered but are moot in view of the new ground(s) of rejection.

8. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 308-9051, (for formal communications intended for entry)

Or:

(703) 305-9508, (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stella Woo whose telephone number is (703) 305-4395. Her supervisor, Curt Kuntz, may be reached at (703) 305-4708.

September 1, 1998

STELLA WOO
PRIMARY EXAMINER